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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,159	10/02/2000	Keting Chu	1581.002/200130.494	4111

27476 7590 11/15/2001

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EXAMINER
GAMBEL, PHILLIP

ART UNIT	PAPER NUMBER
1644	8

DATE MAILED: 11/15/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-23 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☐ Claim(s) _____ is/are rejected.
☐ Claim(s) _____ is/are objected to.
☑ Claim(s) 1-23 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

* U.S. GPO: 1998-421-832/40201

DETAILED ACTION

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1644, Technology Center 1600.

2. Prior to setting forth the restriction requirement, it is pointed out that the claims are drawn to patentably distinct methods and products. The method and products rely upon small molecules, proteins and antibodies which differ in structure and modes of action to such an extent and require non-coextensive searches to such an extent that they are considered separately patentable. Therefore, the restriction will be set forth for each of the various groups, irrespective of the format of the claims, because these are not proper species.

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1, 2 and 9, drawn to compositions comprising CD40-specific small molecules, classified in Class 424, subclass 184.1.

II. Claims 1, 3 and 9, drawn to compositions comprising CD40-specific proteins, classified in Class 514, subclass 2.

III. Claims 1, 4-8 and 9, drawn to compositions comprising CD40-specific antibodies, classified in Class 424, subclass 130.1.

IV. Claims 10, 11, 18-21 and 23, drawn to methods of treating autoimmune diseases with CD40-specific small molecules, classified in Class 424, subclass 184.1. .

V. Claims 10, 11, 18-21 and 23, drawn to methods of treating autoimmune diseases with CD40-specific proteins, classified in Class 514, subclass 2.

VI. Claims 10-21 and 23, drawn to methods of treating autoimmune diseases with CD40-specific antibodies, classified in Class 424, subclass 130.1.

VII. Claim 22, drawn to methods of treating neoplastic diseases with CD40-specific small molecules, classified in Class 424, subclass 184.1. .

VIII. Claim 22, drawn to methods of treating neoplastic diseases with CD40-specific proteins, classified in Class 514, subclass 2.

IX. Claim 22, drawn to methods of treating neoplastic diseases with CD40-specific antibodies, classified in Class 424, subclass 130.1.

4. Inventions (I and IV/ VII), (II and V/VIII) and (III and VI/IV) are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

In the instant case, the products as claimed can be used in a materially different process such as affinity purification, detection assays or as immunogen.

Also, the methods of treating autoimmune and neoplastic diseases can be achieved a host of immunosuppressive or chemotherapeutic regimens and therapeutics.

5. Inventions IV, V, VI, VII, VIII and IX are different methods, which require different ingredients. Therefore, they are patentably distinct.

6. Inventions I, II and III are different products. Small molecules, proteins and antibodies are distinct because their structures and modes of action are different. Therefore, they are patentably distinct.

7. Because these inventions are distinct for the reasons given above and the search required for any group from Groups I-IX is not required for any other group from Groups I-IX and Groups I-IX have acquired a separate status in the art because the searches are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.

8. This application contains claims directed to the following patentably distinct species of the claimed Groups III / IV and VI: wherein the autoimmune disease (e.g. see page 5 and page 8 of the instant specification) is:

A) SLE,
B) rheumatoid arthritis,
C) multiple sclerosis,
D) dermatomyositis,
E) scleroderma,
F) psoriasis, or
G) Hashimoto's thyroiditis.

These species are distinct because the pathological conditions differ in etiologies and therapeutic endpoints.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 10 is generic, for example.

9. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

PHILLIP GAMBEL

Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
November 9 , 2001